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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,535	01/24/2002	Curtis White	BSC-159C1	3017

21323 7590 10/06/2003

TESTA, HURWITZ & THIBEAULT, LLP  
HIGH STREET TOWER  
125 HIGH STREET  
BOSTON, MA 02110

EXAMINER

PRIDDY, MICHAEL B

ART UNIT PAPER NUMBER

3732

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/057,535

Applicant(s)

WHITE ET AL.

Examiner

Michael B Priddy

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 18-23, 25-30 and 33 is/are rejected.
- 7) ☐ Claim(s) 24, 31, 32 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3732

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective because: The reference made to application serial number 09/968,906 from which the present application claims priority is inaccurate. The filing date for the prior application as indicated by PTO records is 11/06/1997 not 11/05/1997 as set forth in the declaration.

### ***Specification***

The disclosure is objected to because of the following informalities: in line 4 of page 2, "November 5, 1997" should be --November 6, 1997--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 18-22, 25, 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Chu et al. (U.S. 6,368,328). Chu et al. teaches a medical retrieval device (Figs. 1A, 2A and 2B) comprising: a proximal handle 8; a sheath 12 extending from the handle 8 and including a lumen 14, the sheath 12 including a distal end 16 away from the handle 8; a retrieval assembly 10 that is moveable relative to the sheath 12 to achieve a collapsed position of the retrieval assembly 10 within the lumen 14, the retrieval assembly 10 comprising: a proximal portion 11 comprising a distal end 28 and a three-dimensional shape when at least a portion of the retrieval assembly 10 extends out of the lumen 14 from the distal end 16 of the sheath 12; and a distal portion 24 positioned at the distal end 28 of the proximal portion 11, the distal portion 24 comprising a flat shape perpendicular to a long axis of the device when the proximal portion 11 extends from the distal end 16 of the sheath 12; wherein the proximal portion 11 of the retrieval assembly comprises a plurality of stainless steel (lines 57-60 of column 8) legs 11a, 11b, 11c each comprising a strand; further comprising a guidewire 18; wherein axial movement of the guidewire 18 in a proximal direction collapses the distal portion 24 of the retrieval assembly 10; wherein moving the sheath 12 in a distal direction causes the retrieval assembly 10 to collapse when it enters the lumen 14.

Concerning the limitations of claim 22 requiring the proximal portion to comprise a rigid material while the distal portion comprises a flexible material, the Examiner

Art Unit: 3732

points out that the legs 11a, 11b, and 11c of Chu et al. are referred to as resilient but are relatively rigid compared to the relatively flexible distal portion 24 which is disclosed as being formed as a net or mesh fabric of fluorocarbon plastic.

Claims 18, 23, 28, 30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Bates (U.S. 6,096,053). Bates teaches a medical retrieval device (Figs. 2 and 5F; See marked-up copy of Fig. 5F attached to this Office Action) comprising: a proximal handle 18; a sheath 12 extending from the handle 18 and including a lumen, the sheath 12 including a distal end away from the handle 18; a retrieval assembly 16 that is moveable relative to the sheath 12 to achieve a collapsed position of the retrieval assembly 16 within the lumen, the retrieval assembly 16 comprising: a proximal portion comprising a distal end and a three-dimensional shape when at least a portion of the retrieval assembly 16 extends out of the lumen from the distal end of the sheath 12; and a distal portion positioned at the distal end of the proximal portion, the distal portion comprising a flat shape perpendicular to a long axis of the device when the proximal portion extends from the distal end of the sheath 12; further comprising a guidewire 14 joined to a central portion 22 of the distal portion of the retrieval assembly; wherein axial movement of the guidewire 14 in a proximal direction collapses the distal portion of the retrieval assembly 16; wherein moving the sheath 12 in a distal direction causes the retrieval assembly 16 to collapse when it enters the lumen. Concerning the language of claim 23 requiring the distal portion of the retrieval assembly comprise a plurality of wires, one should note lines 23-39 of column 3 where Bates describes the construction of mesh portion 16 being of woven fibers or metal wires. Bates describes a method for

Art Unit: 3732

removing an object from a body tract with the retrieval device disclosed in claims 10 and 11.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chu et al. Chu et al., as presented in the above rejection under 35 U.S.C. 102(e) discloses the claimed invention except for a plurality of the distal ends of the strands define a square area when the proximal portion assumes a three-dimensional shape. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the retrieval assembly of Chu et al. of a configuration such that the distal ends of the strands define a square area when the proximal portion assumes the three-dimensional shape since applicant has not disclosed that such solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a distal portion on a retrieval assembly. In re Dailey and Eilers, 149 USPQ 47 (1966).

Art Unit: 3732

***Allowable Subject Matter***

Claims 24, 31, 32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

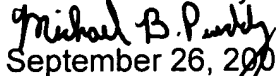
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

  
September 26, 2003

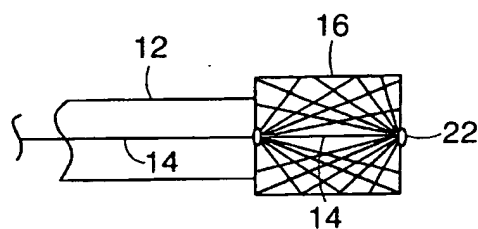


FIG. 5E

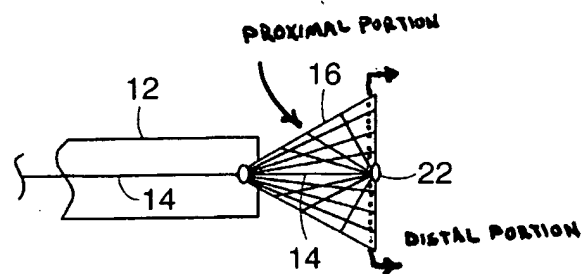


FIG. 5F

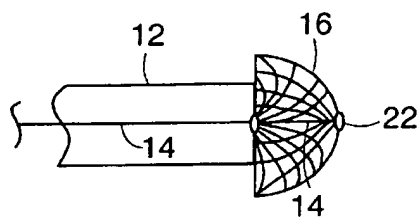


FIG. 5G

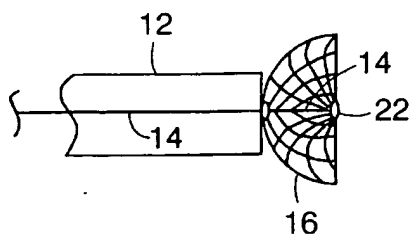


FIG. 5H